

In re Patent Application

Serial No. 09/219,478

Filed: December 22, 1998

Examiner: Michael Pender

Protest under 37 CFR 1.291

**Exhibit A**

**Affidavit of Michael Smialek.**

Affidavit of Michael Robert Smialek

THIS INSTRUMENT HEREBY ACKNOWLEDGES that the undersigned, Michael Robert Smialek, residing at 1548 Meadow Lane, Glenview, IL 60025, is of legal age, and does hereby swear and affirm that the following is true and accurate, to the best of his knowledge and recollection, under penalty of perjury:

1. I was employed at Andersen Consulting from August of 1992 through August of 1998.
2. From July 1995 through August 1998, I was deeply involved in Andersen Consulting's Business Simulation Practice.
3. From July 1995 through May of 1996, I conceived, designed, and developed the rules based expert system known internally at Andersen Consulting as the Tutor.
4. In the claims of the eighteen issued patents related to application 09/219/478, the Tutor is referred to as the "rules based expert system".
5. The "rules based expert system" known internally at Andersen Consulting as the Tutor, had been reduced to practice, was ready for patenting and was in commercial use on an Andersen Consulting engagement for General Electric Corp. in February of 1996. This engagement was called Financial Foundations Course.
6. The key Andersen Consulting executive contacts for the FFC project were William Stoddard, a Partner; Janet Simons, then an Associate Partner, now a Partner; David Smith, then a Manager, now an Associate Partner, Suzanne Pink, formerly a Manager, and Martha O'Connor, formerly a Manager.
7. The key General Electric contacts and sponsors for the FFC project were Nancy Taylor, Neil Flannagan, Eileen Whelly, Steve Kerr, and Dennis Dammermann.
8. In April 1996 I conceived of and conceptually designed the spreadsheet object component known internally at Andersen Consulting as the Simulation Engine.
9. In the claims of the eighteen issued patents related to application 09/219/478, the Simulation Engine is referred to as the "spreadsheet object component".
10. The "spreadsheet object component", known internally at Andersen Consulting as the Simulation Engine, had been reduced to practice, was ready for patenting and was in commercial use on an Andersen Consulting engagement for General Electric Corp. in October of 1996. This engagement was called Financial Accounting for Operations.
11. The "rules based expert system and spreadsheet object component" were used together commercially, in the context of Business Simulation, on the FAO engagement for General Electric Corp. in October of 1996.
12. Except for Suzanne Pink the key Andersen Consulting contacts for the FFC engagement were the same as for the FAO engagement.
13. The key GE contact for the FAO engagement was Paul Beucker (or Beuker?).
14. The "rules based expert system and spreadsheet object component" were demonstrated, offered for sale, and used commercially on an Andersen Consulting engagement for Pratt & Whitney Corp. The sales activities for this project began prior to April of 1997. The project development

began approximately in May of 1997 and ended some time in 1998. This engagement was called Business Decision Making.

15. I performed a presentation and demonstration of Andersen Consulting's business simulation capability for a group of Allstate Insurance, Co. employees on February 20, 1997. I demonstrated the completed GE FFC Business Simulation application, as well as the Tutor and Simulation Engine and their related workbenches. I was directed to deliver this presentation and demonstration by my then manager, Suzanne Pink. The presentation and demonstration took place on Allstate premises in an open area of the cafeteria around lunchtime. It was scheduled and announced several weeks in advance. It was attended by executives and employees.
16. In the eighteen issued patents related to application 09/219/478, the specifications are identical or nearly identical. I believe this is called an omnibus specification. I assume that application 09/219/478 makes use of the same omnibus specification.
17. All of the subject matter in the specification was in commercial use more than one year before the application date of December 22, 1998.
18. Significant parts of the omnibus specification, including text, screen shots, flow charts, and source code samples, were taken from documents that I authored or co-authored between September 1995 and September 1997.
19. I do not know the inventorship for patent application 09/219/478. If the application in any way claims a "rules based expert system with a spreadsheet object component" and I am not listed as an inventor, then the inventorship is incorrect.
20. If the inventorship on patent application 09/219/478 is incorrect, I believe it is incorrect due to a deliberate misrepresentation on the parts of Andersen Consulting and the applying attorney, L. Keith Stephens. I have arrived at the belief that the misrepresentation of inventorship is deliberate because:
  - a. It is well known at Andersen Consulting that I invented the "rules based expert system" and contributed to the invention of the "spreadsheet object component". It is well known at Andersen Consulting that I invented or contributed to the invention of many other Andersen Consulting business simulation tools, technologies, and methods.
  - b. In the omnibus specification I recognize text, screen shots, flow charts, source code, and slides as having been taken from materials I authored during my employment at Andersen Consulting. I have been told by current and former Andersen Consulting employees that L. Keith Stephens drafted the omnibus specification based on said materials and others. My name was displayed prominently on said materials when I authored them. I have been told by current and former Andersen Consulting employees that my name was intact and still prominently displayed when said materials were delivered to L. Keith Stephens.
  - c. My name appears in the eighteen issued patents in a source code sample that is part of the omnibus specification.
  - d. Eric Lannert is a former Andersen Consulting employee and a named inventor on related patents that use the omnibus specification (patents 6073127, 6029159, 6029156, 6026386). Eric Lannert verbally stated to me that during interviews with L. Keith Stephens prior to the filing of the patents, he stated to L. Keith Stephens that I (Michael Smialek) was a contributing inventor and should be named as such in the patents.

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- e. William Stoddard initiated the patent application activities. On several occasions prior to and subsequent to the filing date, I explained the rules regarding the statutory bar, accuracy of inventorship, and duty of disclosure to William Stoddard. On each occasion his reply was to the effect that "our lawyers have found a way around those issues."
21. William Stoddard called me on 3/28/2000. I took careful notes during the conversation. When I confronted him with the inventorship and statutory bar issues, he conceded that the "Tutor is prior art" and the "Simulation Engine is prior art". He also stated "You weren't here, so you weren't named". I took this to mean that I didn't deserve to be named as an inventor because I was no longer employed at Andersen Consulting.
22. From September 1998 – November 1998 Andersen Consulting contracted with me to set up and deliver a 5-day training course to teach Andersen Consulting employees how to use the Tutor, the Simulation Engine, and several other tools and related workbenches. Andersen Consulting contracted with me to conduct two sessions of the course. This time frame was just before the filing date of the applications and there was much activity related to the patent applications. During this period I had face-to-face contact with several Andersen Consulting employees involved in the filing including Eric Lannert, John Hubbell and Brian Beams, among others. This contact occurred on Andersen Consulting premises. At this time I clearly and repeatedly explained the patent laws regarding accuracy of inventorship and statutory bar to Eric Lannert, John Hubbell and Brian Beams. At this time I had never heard of L. Keith Stephens. In several subsequent conversations with Eric Lannert, John Hubbell and Brian Beams, they told me that they conveyed the information regarding my contributions to the inventions and the commercial uses of the inventions to the attorneys involved in the applications.
23. I believe that direct questioning of named inventors of application 09/219/478 and the Andersen Consulting contacts from the FFC or FAO engagements will result in the conclusions that a) I am the primary or a contributing inventor to nearly all subject matter in the omnibus specification; and b) the subject matter of the omnibus specification is ineligible for patent due to commercial uses more than a year before the filing date.
24. I believe that the evidence presented in the protest of application 09/219/478 submitted by me on 7/14/2000 represents only a fraction of the available evidence that proves that the subject matter of the omnibus specification is ineligible for patent. I believe that much more evidence supporting ineligibility is available in internal Andersen Consulting documents and project records.

Signed this day:



Michael Robert Smialek



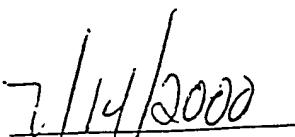
Date

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23. I believe that any direct questioning of named inventors of application 09/219/478 and the 24 related applications regarding inventorship and commercial uses will result in a conclusion that the subject matter of the omnibus specification is ineligible for patent. I believe that direct questioning of the Andersen Consulting contacts from the FFC or FAO engagements will result in a conclusion
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Signed this day:



Michael Robert Smialek



Date